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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/681,274	03/12/2001	John Acres	336018001US2	8594

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EXAMINER	
JEANTY, ROMAIN	
ART UNIT	**PAPER NUMBER**
3623	

DATE MAILED: 01/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/681,274	ACRES, JOHN	
	Examiner	Art Unit	
	Romain Jeanty	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-62 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-62 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This Non-Final Office Action is in response to the communication received on March 01, 2001. Claims 1-60 are pending in the application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 33 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 37 recites the limitation "the server computer" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claims 34-40 depend from independent claim 1; and are therefore rejected under the same rationale relied upon rejected claim 1.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 4, 10-14, 21-24, 41, 43-47, 54-59, and 61-62 are rejected under 35 U.S.C. 102(b) as being anticipated by Ebisawa (U.S. Patent No. 5,946,664).

As per claims 1, 8, 41, and 58-59, Ebisawa discloses an advertisement system comprising:

receiving a collection of advertisements from a server computer via a communications link (col. 2, lines 20-22);

storing the received collection of advertisements (col. 2, lines 13-14); and

starting execution of the computer game to be played by the user, the computer game to be executed by the computer; while the user is playing the computer game (col. 2, lines 23-35),

selecting an advertisement from the stored collection of advertisements; and displaying the selected advertisement so that the user can view the selected advertisement while playing the computer game (col. 2, lines 42-46).

As per claim 4, Ebisawa further discloses selecting another advertisement from the stored collection and displaying the selected other advertisement while the user is playing the computer game (col. 2, lines 23-29).

As per claims 10, 43, and 61, Ebisawa further discloses during execution of the computer program on the computer, selecting another advertisement from the provided collection of advertisements and outputting the selected advertisement (i.e., downloading new advertisement every time the game is executed) (col. 5, lines 44-57).

As per claims 11, 44, and 62, Ebisawa further discloses storing indications of the output advertisements (col. 2, lines 42-45).

As per claims 12, and 45, Ebisawa further disclose sending to a server computer the

stored indications (col. 2, lines 42-45).

As per claims 13 and 46, Ebisawa further discloses receiving from the user a selection of an output advertisement, and storing an indication that the user selected the output advertisement (col. 5, lines 44-57).

As per claims 14 and 47, Ebisawa further discloses sending to a server computer the stored indication (col. 5, lines 4-12).

As per claims 21, and 54, Ebisawa further discloses wherein the collection of advertisements is provided by a server computer (See figure 11).

As per claims 22, and 55, Ebisawa further disclose wherein the selecting and outputting are under control of the executing computer program (col. 4, lines 23-29).

As per claims 23, and 56, Ebisawa further discloses wherein the selecting and outputting are under control of another executing computer program (col. 4, lines 23-29).

As per claims 24, and 57, Ebisawa further disclose wherein the outputting includes displaying the selected advertisement (col. 5, lines 32-37).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ebisawa (U.S. Patent No. 5,946,664) in view of Merriman et al (U.S. Patent No. 5,948,061).

As per claims 2, Ebisawa does not expressly disclose tracking when the displayed advertisement is selected by the user. Merriman et al in the same field of endeavor, teaches the concept of tracking the exposure of an advertisement to a user (col. 6 line60 through col. 7 line 14). Therefore, it would have been obvious to a person of ordinary skill in the art to modify the computer game system of Ebisawa to include the teachings of Merriman et al order to compile information that can be used for targeting advertising

As per claim 3, Ebisawa further discloses sending to a server computer an indication that the advertisement was selected by the user (col. 2, lines 23-29).

8. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ebisawa (U.S. Patent No. 5,946,664) in view of Wendkos (U.S. Patent No. 5,983,196).

As per claims 5-7, Ebisawa discloses all of the limitations in claim 1 above, but fails to expressly disclose rewarding the user based on time spent playing the game, rewarding the user based on speed at which the user completes the game, and rewarding the user based on performance of the user at playing the game relative to performance of other users at playing the game.

Wendkos in the same field of endeavor, discloses interactive computerized methods and apparatus for conducting an incentive awards program which teaches the concept of awarding a user for playing a game (col. 16, line 49 through col. 17, line 11). It would have been obvious to a person of ordinary skill in the art to modify the disclosures of Ebisawa to incorporate warding the user for playing a game as taught by Windows in order to encourage the user to play the game.

9. Claims 9, 19-20, 32, 40, 42, 52-53, and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ebisawa (U.S. Patent No. 5,946,664) in view of Shaw et al (U.S. Patent No. 6,516,341).

As per claims 9, 19-20, 32, 40, 42, 52-53, and 60, Ebisawa does not expressly teach providing additional advertisements to the computer, and selecting another advertisement from the provided collection of advertisements; and outputting the selected other advertisement. Shaw in the same field of endeavor, discloses the concept of displaying additional advertisements to user (col. 5, lines 60 through col. 6 line 4). Therefore, it would have been obvious to a person of ordinary skill in the art to modify the computer game system of Ebisawa to include the teachings of Shaw et al in order to allow the user to view other related advertisements.

10. Claims 15-18, 27, 35, 48-51 rejected under 35 U.S.C. 103(a) as being unpatentable over Ebisawa (U.S. Patent No. 5,946,664) in view of Goldberg et al (U.S. Patent No. 6,183,366).

As per claims 15-18, 27, 35, and 48-51, Ebisawa does not expressly disclose wherein the selection of the advertisement is based on a characteristic of the user, wherein the provided collection is based on a characteristic of the user, wherein the computer program is a game and including collecting statistics relating to the game, and sending the collected statistics to a server computer. Goldgerg et al in the same field of endeavor, discloses selection of advertisement based on user characteristic and maintaining statistics about the game being placed (col. 22, lines 1-66 and col. 25, lines 22-36).

11. Claim 25-26, 28-31, 34, and 36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ebisawa (U.S. Patent No. 5,946,664).

As per claims 25-26, 28-31, 33-34, and 36-39, Ebisawa teaches all of the limitations in claim 1 with the obvious difference that the client computer is offline "not connected" from the computer network for connecting the client computer to the server computer. However, it is old and well known in the computer art to store information to a client computer while the user's computer is in offline from a network. A person having ordinary skill in the art would have been motivated to include a user's computer the client computer is offline from the computer network for connecting the client computer to the server computer in the disclosures of Ebisawa in order to reduce traffic activity. Applicant is directed to col. 4, lines 51-56 of U.S. Patent No. 5,886,693 issued to Ho et al.

As per claims 26 and 34, Ebisawa further discloses sending to a server computer an indication that the advertisement was selected by the user (col. 2, lines 23-29).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

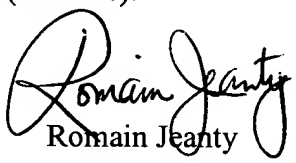
a. Goldberg et al (U.S. Patent No. 6,183,366) disclose a network game system.

b. Goldberg et al (U.S. Patent No. 6,264,560) discloses a game playing method for playing over the a network

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Romain Jeanty whose telephone number is (703) 308-9585. The examiner can normally be reached on Mon-Thurs 7:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq R Hafiz can be reached on (703) 305-9643. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Romain Jeanty

Primary Examiner

Art Unit 3623

1/10/05